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Amdt. dated September 30, 2003
Response to Office Action Mailed September 11, 2003

REMARKS

Claims 3, 8, 13, 15, 20, 25, 27, and 31 have been amended to correct minor typographical errors or to further define the present invention. Claims 1-44 remain in this application.

For the reasons discussed, the objections and rejections are traversed. It is Applicants' belief that the objections and rejections should be withdrawn and the claims passed to allowance.

A. Claim Rejection - 35 U.S.C. §112

Claims 10, 22, and 29 are rejected under 35 U.S.C. §112 as being indefinite because the phrase "juxtaposed to the body" is not understood. With all due respect, Applicants submit that the rejection on this basis is improper and should be withdrawn.

OK The term "juxtaposed" has a common ordinary meaning, namely, to place side by side. See e.g., *The American Heritage Dictionary of The English Language*, 951 (4th Ed. 2000). For example, claim 10, which reads, "[t]he apparatus of claim 1 further comprising a support juxtaposed to the body, wherein the support includes at least one bracket configured to support at least the head rail, the bottom rail and the blind slats" simply states that the support is positioned side by side with the body. Such a common and ordinary meaning would be well understood by a person skilled in the art. Thus, rejected claims 10, 22, and 29 are not indefinite. Applicants respectfully request that the rejection of claims 10, 22, and 29 on this basis be withdrawn.

B. Claim Rejection - 35 U.S.C. §103

Claims 1-10, 12-22, 24-29, 31-36, 38-41, 43, and 44 are rejected as being unpatentable over Marocco '394 in view of Stevens and Wang '172. Claims 11, 23, 30, 37, and 42 are rejected

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as being unpatentable over Marocco '394 in view of Stevens and Wang '172, and in further view of Sudano. Applicants respectfully disagree with the conclusions of the Office Action and traverse the rejections.

A rejection based on 35 U.S.C. 103, requires that certain tenets of patent law be followed: (A) the claimed invention must be considered as a whole; (B) the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986).

The Patent Office bears the initial burden of factually supporting and establishing a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); MPEP §2142. Only if this burden is met does the burden shift to the applicant. *Id.* at 1532, 28 USPQ2d at 1956. When the references cited by the examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim

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limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP §2142, citing, *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants submit that the Office Action fails to satisfy any of these criteria, and therefore has not established a *prima facie* case of obviousness. In particular, the cited prior art does not disclose all elements of the claimed invention. Further, there is no evidence of a suggestion or teaching to combine the references. As such, rejection of the aforementioned claims based on obviousness should be withdrawn.

1. The Combination Of The Cited Prior Art Does Not Teach The Present Invention

As stated, in order to establish a *prima facie* case of obviousness, the Patent Office must demonstrate that the cited prior art discloses or suggests all the claim limitations. MPEP §2142. None of the prior art relied upon in the Office Action discloses an apparatus having a die plate for cutting the head rail, and a separate blade assembly component for cutting the bottom rail and blind slats. Furthermore, none of the prior art relied upon in the Office Action discloses a manually operated drive mechanism to cause the blade assembly to cut the bottom rail and the blind slats.

a. Marocco '394 Does Not Disclose A Blade Assembly For Cutting The Bottom Rail And The Blind Slats

It is incorrectly asserted in the Office Action that the Marocco '394 patent discloses "a linearly movable blade assembly (60, 68) to cut the bottom rail and the blind slats..." Instead, the

Correct but check
other refs
(Wang)
Please
re Wang '557?

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bottom rail in the Marocco '394 patent is taught as being cut by the same die plate that cuts the head rail.

The apparatus for trimming the headrail and the bottom rail consists of a die plate 30, which is slidably mounted on one side of the main support body 14 by means of lower guide 32 and upper guide 34. ... **In order to cut the headrail, a headrail cutting recess 38 is provided in die plate 30. ... The bottom rail cutting is effected by means of a bottom rail cutting recess 40 formed in die plate 30,** and adapted to register with the bottom rail opening 18 in support body 14 in one position, and to be out of registration in another position. **Thus movement of the die plate 30 between one position and another position, once the headrail and the bottom rail have been inserted into respective openings and recesses, will produce cutting or trimming of the ends of both the headrail and the bottom rail** (Marocco '394, col. 5, ll. 18-50).

In all embodiments, the head rail and the bottom rail are cut by the same component, such as a die plate. The cutting of the blind slats is done with a different component than that which cuts the bottom rail.

The trimming of the blind slats S is carried out in this embodiment as a separate function from the trimming of the headrail and the bottom rail. For this purpose in this embodiment, a blade mounting frame 60 is slidably mounted on main body 14, between main body 14 and the die plate 30. The blade mounting frame 60 is of rectangular shape and defines an interior space 66. At one end (right hand end of FIGS. 4 and 5) a blade 68 is mounted on the frame 60. movement of the blade 68 will shear the ends of the slats S, against the support of the arcuate slat supports 70 and 72, thereby providing a clean cut on each slat end. The centre portion of the blade 68 moves in the same plane as the interior surface of the die plate 30. (Marocco '394, col. 6, l. 48 - col. 7, l. 4).

By contrast, with the present invention, a single blade assembly cuts both the bottom rail and the blind slats. Therefore, the Marocco '394 patent does not disclose an apparatus having a linearly movable blade assembly to cut the bottom rail and the blind slats.

OK, but Marocco 394 does

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The Wang '172 patent also fails to disclose the combination of a die plate for cutting a head rail and a separate blade assembly for linearly cutting a bottom rail and blind slats. Cutting tool 50 in Wang '172 is shown as cutting the head rail, blind slats and bottom rail. (Wang, FIG. 3). Unlike the claimed invention, Wang '172 discloses a single component for linearly cutting the head rail, the bottom rail, and the blind slats. Such an arrangement does not afford the cutting machine the mechanical advantage achieved with the present invention, which is why a power cylinder is required to operate the Wang '172 machine.

The Stevens patent also does not disclose the combination of a die plate for rotatably cutting a head rail and a blade assembly for linearly cutting a bottom rail and blind slats. The Stevens patent is not at all directed to the trimming of a Venetian blind. As such, there is no discussion of cutting a bottom rail and blind slats. Therefore this element is missing from the Stevens patent as well. *Capable of*

Accordingly, none of the prior art relied upon in the Office Action discloses the claimed head rail cutter and blade assembly for cutting the bottom rail and blind slats. Thus, no *prima facie* case of obviousness has been established.

b. The Cited Art Does Not Disclose A Drive Mechanism To Cause A Blade Assembly Cut The Bottom Rail And The Blind Slats

The Marocco '394 patent also does not disclose a drive mechanism to cause a die plate to cut the head rail and to cause a blade assembly to cut both the bottom rail and the blind slats. For the reasons discussed above, the Marocco '394 patent fails to disclose a component that cuts both

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the bottom rail and the blind slats. Therefore, no drive mechanism is disclosed that would move such a blade assembly to cut the bottom rail and blind slats.

Therefore, this element is also missing from the prior art relied upon in the Office Action. As such, no *prima facie* case of infringement has been established.

c. Marocco '394 Does Not Disclose The Additional Limitations of Claims 2, 3, 5, 15, 16, 31, and 33

The Office Action relies on Marocco '394 for its rejection of claims 2, 3, 5, 15, 16, 31, and 33. Applicants respectfully submit that the rationale of the Office Action is incorrect.

The Office Action incorrectly states that the Marocco '394 patent discloses "a blade housing (60), first blade for cutting the bottom rail having an open profile (18, 40) along its cross sectional axis, second blade for cutting the blind slats." As discussed above, it is die plate 30 in Marocco '394 that cuts both the head rail and the bottom rail. Blade housing 60 does not cut the bottom rail, or any other blind component. Blade housing 60, as its name implies, merely holds blade 68 which cuts the blind slats only. Therefore, the Marocco '394 patent fails to disclose this element of claims 2, 3, 5, 15, 16, 31, and 33, and thus, no *prima facie* case of obviousness has been established.

d. Marocco '394 Does Not Disclose The Additional Limitations of Claims 4, 17, and 32

It is stated in the Office Action that Marocco '394 teaches a first blade (Fig. 3, 51) configured to cut a bottom rail having a closed profile. With all due respect, no such teaching exists in Marocco '394. None of the embodiments in Marocco '394 show a bottom rail having a

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closed profile. Figure 3 does not even disclose a component 51, nor is a component 51 found anywhere in the Morocco '394 patent. As such, Applicants request further clarification of the rejection of claims 4, 17, and 32 on this basis. *capable of cutting closed bottom rail*

e. Marocco '394 Does Not Disclose The Additional Limitations of Claims 13 and 25

capable of cutting
The Marocco '394 patent is also relied upon as disclosing tooth-like projections in a head rail aperture for a Venetian blind cutter. This too is incorrect. Each of the claims is directed to cutting at least three components of a Venetian blind, namely, the head rail, bottom rail and blind slats. By contrast, the U-shaped recess 204 disclosed in the Marocco '394 patent is for cutting the head rail of a vertical blind, not a Venetian blind. (Marocco '394, col. 9, ll. 50-57). The cutting of the head rail of a vertical blind does not also cut blind slats, or a bottom rail (which does not exist with a vertical blind). The Marocco '394 patent also fails to indicate whether the purported tooth-like projections are for piercing the head rail, as opposed to merely matching the profile of the vertical blind head rail. There is also no discussion in Marocco '394 of utilizing tooth-like projections to make easier the cutting of a head rail. Instead, Marocco '394 only discloses creating a mechanical advantage from separating the force for cutting the head rail and bottom rail from the force for cutting the blind slats. Accordingly, the Marocco '394 patent fails to disclose the limitations of claims 13 and 25.

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f. The Sudano Patent Does Not Disclose A Blind Slats Clamp

The clamping mechanism of Sudano is to clamp an entire Venetian blind within a cutting apparatus. Claims 11, 23, 30, 37, and 42 require a blind slats clamp. The Sudano clamping mechanism is simply not a blind slats clamp. Instead, it clamps the entire Venetian blind. So? 1388 put it

2. No Teaching Or Suggestion In Cited Art To Combine References

A second requirement of the Patent Office to establish a *prima facie* case of obviousness is that the Patent Office must provide evidence of "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 837 at 1074, 5 USPQ2d at 1598; see also MPEP §2143.01. "The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). Absent a showing of a motivation to combine, no *prima facie* case of obviousness can be established, and the rejection must be withdrawn. See e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52 (Fed. Cir. 2001).

Despite this requirement of proof, the Office Action fails to provide any evidence of, or even a mention of the need for a suggestion or teaching in the prior art to combine the cited art in a manner to arrive at the invention as claimed in the present application. Therefore, the Patent Office has not satisfied its burden of establishing a *prima facie* case of obviousness, and the rejections on this basis should be withdrawn.

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Applicants further submit that there is no suggestion of a desirability to combine the cited references. Indeed, the cited references, taken as a whole, suggest against combining the references. For example, the Marocco '394 patent states that it is undesirable to utilize a power actuated drive such as that disclosed in the Wang '172 patent.

This feature advantageously reduces the total force that must be applied to achieve cutting, and so permits the cutting operation to be performed by a manual means. Of course, it is possible that the entire operation can be power operated as will become apparent below, although it is believed that this would unnecessarily increase the cost of the apparatus. (Marocco '394 patent, col. 6, ll. 1-7).

Also, it would be entirely unnecessary to separate the cutting procedure as is taught in the Marocco '394 patent when using a power cylinder as taught by the Wang '172 patent. As such, there would be no motivation for one to combine the machine of the Marocco '394 patent with the machine of the Wang '172 patent.

There is also no suggestion as to why or how one would combine the teachings of the Stevens patent with the Marocco '394 or the Wang '172 patents. As discussed, the Marocco '394 patent creates a mechanical advantage by separating the forces for cutting the head rail and bottom rail from the force to cut the blind slats. In so doing, a mechanical advantage is achieved that permits manual cutting. Therefore, there is no suggestion that any additional mechanical advantage is required, and thus, there is no reason provided in the cited prior art to combine the Stevens patent with the Marocco '394 patent.

Similarly, the Wang '172 patent does not teach of the desire for creating any mechanical advantage because it utilizes a power cylinder to drive the cutting components. Accordingly,

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there would be no reason for a person skilled in the art to combine the teachings of the Stevens patent with the Wang '172 patent.

As such, the rejections should be withdrawn for the reason that the prior art fails to provide a suggestion or teaching to combine the references.

3. The Marocco '394 and Wang '172 Patents Teach Away From The Claimed Invention

A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Each of the Marocco '394 and Wang '172 patents teach away from the claimed invention, and therefore, do not render obvious the claimed invention.

a. The Marocco '394 Patent Teaches Away From The Claimed Invention

As conceded in the Office Action, the Marocco '394 patent teaches away from cutting the various blind components at the same time. Indeed, every embodiment disclosed in the Marocco '394 patent teaches the cutting of the head rail and bottom rail separate from the cutting of the blind slats. "The trimming of the blind slats S is carried out in this embodiment as a separate function from the trimming of the headrail and the bottom rail." (col. 6, ll. 48-50). The reason for this is explained in the Marocco '394 patent specification.

This feature advantageously reduces the total force that must be applied to achieve cutting, and so permits the cutting operation to be performed by a manual means. (col. 6, ll. 1-3).

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This method of reducing the force required to cut Venetian blind components is contrary to the approach in the present invention of obtaining a mechanical advantage. As acknowledged in the Office Action, a specific claim element of the present invention is the concurrent cutting of the head rail, bottom rail, and blind slats. Thus, to achieve a mechanical advantage, the present invention utilizes a die plate that cuts the head rail with a rotational movement of the die plate.

As explained in the present application:

Because at least one of the plates of the die is designed to move in a rotational manner to cut the head rail, less force is required to cut the head rail than if a die plate were moved along a linear path. Since less force is required to cut the head rail, the bottom rail and blind slats may be trimmed concurrently with the head rail, without any part of the operation requiring an undue amount of force to be exerted by the user. (p. 5).

The Marocco '394 patent, on the other hand, teaches that in order to achieve a mechanical advantage, one must separate the cutting of the different blind components. As such, the Marocco '394 patent teaches away from the claimed invention.

b. The Wang '172 Patent Teaches Away From The Claimed Invention

Applicants further submit that the Wang '172 also teaches away from the claimed invention. The Wang patent discloses a power driven cylinder, such that it is unnecessary to reduce the force required for cutting the blind components in the manner of the claimed invention.

The Wang '172 patent discloses only a power driven method and apparatus for cutting blind components. By contrast, the claimed invention reduces the total amount of force required to cut Venetian blind components such that a power cylinder is not required. Therefore, the added cost and complexity of a power driven apparatus may be avoided. There is no recognition

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in the Wang '172 patent of any desire to reduce the amount of force required during the cutting operation. This is because the Wang '172 patent teaches an apparatus that is driven by a power cylinder, and therefore, teaches away from the claimed invention.

C. Claim Objections

Amendments to claims 3, 8, 13, 15, 20, 25, 27, and 31 are made to correct minor typographical errors. As such, Applicants respectfully request withdrawal of the claim objections.

D. Conclusion

For the reasons stated above, Applicants traverse the objections and rejections and request withdrawal thereof. Applicants respectfully submit that the application is in condition for allowance and request same.

Respectfully submitted,

Date: September 30, 2003

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